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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/973,671	10/09/2001	Hidetaka Magoshi	100809-16271 (SCEY 19.057	5777
26304	7590	02/01/2006	EXAMINER BOVEJA, NAMRATA	
KATTEN MUCHIN ROSENMAN LLP 575 MADISON AVENUE NEW YORK, NY 10022-2585			ART UNIT 3622	PAPER NUMBER

DATE MAILED: 02/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/973,671

Applicant(s)

MAGOSHI, HIDETAKA

Examiner

Namrata Boveja

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10/09/2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/09/01 & 2/14/02</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. Claims 1-17 are presented for examination.

Claim Rejections - 35 USC § 112

The second paragraph of 35 U.S.C. 112 is directed to requirements for the claims:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

There are two separate requirements set forth in this paragraph:

(A) the claims must set forth the subject matter that applicants regard as their invention; and

(B) the claims must particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant.

2. Claims 2, 5, 8, 11, 12, and 14 are rejected under 35 U.S.C. 112.

Claims 2, 5, 8, 11, and 14 teach setting fees for the service beneficiaries at **stages**. It is unclear what is the meaning of the term **stages** in the claim. It is interpreted to mean that a variable fee structure is provided to the service beneficiaries.

3. Claims 12 teaches a client terminal unit with a **changing means** for assigning a change. It is unclear what is the meaning of the term **changing means** in the claim. It is interpreted to mean that there is a user interface or a webpage using which the client changes the type of service he desires.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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4. Claims 1, 3, 4, 6, 7, 9, 10, 12, 13, 15, 16, and 17 are rejected under 102(b) as being anticipated by the article written by David DeKok titled "Low-priced Internet access offered Subscribers would see floating ad banners on PCs" in the Patriot – News on August 12, 1999 on page B.07 (hereinafter DeKok).

In reference to claims 1 and 16, DeKok teaches a method of providing services and a service-providing program that makes a computer execute the steps of: making service beneficiaries select at least one of the frequency and the quantity of advertising to be added the services provided (i.e. seeing an advertisement all the time or none of the time) (page 1 lines 1-2 and 16-17 and page 2 lines 27-29); and setting a fee for the provision of services (i.e. discounted or regular priced access) to the service beneficiaries, according to at least one of the frequency and the quantity of advertising selected (i.e. seeing an advertisement all the time or none of the time) (page 1 lines 1-2 and 7-17 and page 2 lines 27-29).

5. In reference to claims 3, 6, and 9, DeKok teaches a method, computer-readable medium (i.e. a website accessed via a computer) (page 2 lines 30-33), and the program-executing apparatus (i.e. a computer) of providing services and the program-executing apparatus, wherein, at least one of the frequency and the quantity advertising selected can be changed during the provision the services (i.e. the monthly plan with advertising is \$5.95 a month and without it is \$9.95 a month, and hence the user can change the quantity of advertising during the provision of the service by selecting among the two price plans) (page 1 lines 1-2, 8-9, and 16-17).

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6. In reference to claims 4 and 7, DeKok teaches a computer-readable recording medium recorded with service-providing program and a program-executing apparatus for executing a computer program, service-providing program comprising and making a computer execute the steps of (i.e. letting consumers sign-up for the service using a computer) (page 2 lines 30-33): making service beneficiaries select least one of the frequency and the quantity of advertising to be added to the services provided (i.e. seeing an advertisement all the time or none of the time) (page 1 lines 1-2 and 16-17 and page 2 lines 27-29); and setting a fee for the provision of services to the service beneficiaries (i.e. discounted or regular priced access), according to least one frequency and the quantity of advertising selected (i.e. seeing an advertisement all the time or none of the time) (i.e. discounted or regular priced access) (page 1 lines 1-2 and 7-17 and page 2 lines 27-29).

7. In reference to claim 10, DeKok teaches a contents distribution system (i.e. and Internet Service Providers (ISPs) contents distribution system), comprising: client terminal unit connected to a predetermined network (i.e. to access the website, the user computer has to be connected to a network) (page 2 lines 25-33), and having selecting means (i.e. signing up for the respective plan online with or without the advertisements) for selecting at least one of the frequency and the quantity advertising be added to the contents be distributed (page 2 lines 30-33); and distribution unit having distribution means distributing the contents added with the advertising corresponding to least of frequency and the quantity selected by the selecting means of the client terminal the client

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terminal via the predetermined network (i.e. providing the ad banner with the subsidized service) (page 1 1-2, 8-11, and 16-17), and charging means for charging a fee contents distributed to the client terminal unit (i.e. user can sign up for the service online), according to at least one of the frequency and the quantity of advertising selected by the selecting means the client terminal unit (page 1 lines 1-2, 8-9, and 16-17 and page 2 lines 21-22 and 27-33).

8. In reference to claims 13 and 17, DeKok teaches a computer-readable recording medium recorded with a contents distribution program and a contents distribution program, the contents distribution program comprising and making a computer execute the steps of: making a client terminal unit connected to predetermined network select at least one of the frequency and the quantity of advertising to be added to the contents to be distributed (i.e. the user makes a decision which plan the user wants, the \$5.95 per month plan with advertisements or the \$9.95 per month plan without advertisements when the user signs up for the service with the ISP online) (page 1 lines 1-2, 8-9, and 16-17 and page 2 lines 30-31); making a distribution unit connected to the predetermined network add the advertising corresponding to at least one of the frequency and the quantity selected by the client terminal unit to the contents, and distribute the contents added with the advertising to the client terminal unit (i.e. provide access with or without the floating ad banner) (page 1 lines 1-2, 8-9, and 16-17 and page 2 lines 27-29); and making the distribution unit charge a fee for the contents distributed to the client terminal unit, according to at least one of the frequency and the quantity of advertising selected by the client terminal unit

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(i.e. user can pay either a \$5.95 per month fee with advertisements, a \$99.95 lifetime payment with advertisements, or a \$9.95 per month fee without advertisements) (page 1 lines 1-2, 8-9, and 16-17 and page 2 lines 21-22).

9. **Disclaimer:** Claim 12 was found to be deficient under U.S.C. 112 second paragraph. To the extent the claimed invention was understood, the following art was applied.

In reference to claims 12 and 15, DeKok teaches the contents distribution system wherein the client terminal unit has changing means for assigning a change and the computer-readable recording medium comprising and making a computer assign a change in at least one of the frequency and the quantity of advertising during the reception of the contents (i.e. user can select which service plan the user desires, the \$5.95 per month one with advertising or the \$9.95 per month one without advertising) (page 1 lines 1-2, 8-9, and 16-17), and the distribution means of the distribution unit adds the advertising according to at least one of the frequency and the quantity changed by the changing means of the client terminal unit, and distributes the contents added with the advertising to the client terminal unit (i.e. the ISP adds the advertising banner if the user selects the \$5.95 per month plan) (page 1 lines 1-2 and 8-11 and page 2 lines 27-29).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. **Disclaimer:** Claims 2, 5, 8, 11, and 14 were found to be deficient under U.S.C. 112 second paragraph. To the extent the claimed invention was understood, the following art was applied.

Claims 2, 5, 8, 11, and 14 are rejected under U.S.C. 103(a) as being unpatentable over DeKok in view of the article written by Lashabi Britton titled "Free at last" in the Black Enterprise in November 2000 in volume 31, issue 4, and on page 70 (hereinafter Britton).

In reference to claims 2, 5, 8, 11, and 14, DeKok teaches the method, computer-readable medium (i.e. a website accessed via a computer) (page 2 lines 30-33) of providing services, the program-executing apparatus (i.e. a computer and a website), the contents distribution system (i.e. an ISP's content distribution system), and the computer-readable recording medium recorded with a contents distribution program that makes a compute execute the steps of setting fees wherein the fees charged for the services to be provided to the service beneficiaries are set at stages (i.e. the amount charged is variable based on advertising content), according to at least one of the frequency and the quantity of advertising selected (page 1 lines 1-2, 8-9, and 16-17).

In reference to claims 2, 5, 8, 11, and 14, DeKok does not teach the method of providing services wherein the fees charged for the services to be provided to the service beneficiaries include free of charge. Britton specifically

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teaches providing free of charge services to the service beneficiaries (page 1 lines 1-5 and 7-14, page 2 lines 19 and 27-34). It would have been obvious to modify DeKok to include the free of charge option for service beneficiaries to further lower the costs of providing service access to customers who are willing to view even a greater amount of advertising in order to further subsidize access fees.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure include the following.

- a) Shaw Patent Number 5,809,242. Teaches a method for displaying advertisements to subsidize electronic mail service.
- b) Toader Patent Number 5,749,075. Teaches the method for providing prepaid Internet access including the distribution of specialized calling cards.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Namrata (Pinky) Boveja whose telephone number is 571-272-8105. The examiner can normally be reached on Mon-Fri, 8:30 am to 5:00 pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The **Central FAX** number for the organization where this application or proceeding is assigned is **571-273-8300**.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 1866-217-9197 (toll-free).

NB

January 24th, 2006



FAQUEL ALVAREZ
PRIMARY EXAMINER